

REMARKS

In response to the Office Action mailed August 18, 2003, Applicant provides the present Amendment. In response to the Office Action, applicant has amended claims 18 and 40 and added new claims 47-58. In view of the Amendments and Remarks below, Applicant believes the application is in condition for allowance.

Claims 1-46 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,605,506 to Hoorn et al. (Hoorn) in view of U.S. Patent No. 6,265,984 to Molinaroli (Mol). Applicant respectfully traverses this rejection because it would not have been obvious to one of ordinary skill in the art in view of Mol and Hoorn to arrive at Applicant's claimed invention. Presently, applicant has amended independent claims 18 and 40. These amended claims, new claims 47-58, previously presented claims and original claims all include elements that are not taught or suggested by Hoorn or Mol. For example, amended claim 18 requires a processor automatically triggering the first customized illumination pattern of the external visual indicator upon the occurrence of the first special event. As discuss in detail below, neither Hoorn nor Mol, alone or in combination teach or suggest the limitations of claim 18.

Likewise, neither Hoorn nor Mol, alone or in combination, teach or suggest amended claim 40 that requires automatically triggering the first multi-colored illumination pattern to be displayed within a single stage of the candle that is selected via a user input panel (see detailed discussion below). Further, new claim 47 requires an operation sequence including a first special event and a second special event, and the operation sequence triggered by the input operation of the programmed processor to illuminate the first color display upon occurrence of the first special event and automatically triggering the second color display upon occurrence of the

second special event. Neither Hoorn nor Mol, alone or in combination, teach or suggest the limitations of claim 47, as discussed in detail below.

Furthermore, claim 1 is not taught or suggested by Hoorn or Mol, either alone or in combination. As confirmed by declarant Lawrence DeMar, "Because Mol fails to disclose a display device or indicator for gaming machines and is not pertinent to the problems of concern in the present invention, I believe one of ordinary skill in the art of the present invention would not have considered Mol and therefore it would not have been obvious to one of ordinary skill in the art in view of Mol and Hoorn to arrive at the presently claimed invention." (See attached Rule 132 Declaration of Lawrence E. DeMar ("DeMar Declaration"), paragraph 10). Therefore, all claims are allowable and the rejection of claims 1-46 is respectfully requested to be withdrawn.

CLAIM 1

Claim 1 of Applicant's invention requires a stationary external visual indicator mounted to the gaming machine. The external visual indicator includes multiple LEDs providing a color display including illumination of multiple colors. The claimed invention also includes a programmed processor providing for the control of the color display of the external visual indicator. Hoorn fails to teach or suggest all of these elements. Hoorn fails to disclose a visual indicator of a gaming machine including multiple LEDs. Hoorn also fails to disclose a processor of a gaming machine providing for control of the color display of the external visual indicator. Therefore, all of the elements of the claimed invention are not disclosed in Hoorn (see DeMar Declaration, paragraph 17).

Mol fails to teach or suggest all the elements of claim 1 and Mol is not concerned with the same field as Hoorn or the present invention. Mol fails to teach or suggest the use of a

display device for a gaming machine (see DeMar Declaration, paragraph 8). As well, Mol fails to teach or suggest a stationary light display device or a device in which the light emitters of the device may remain stationary for operation of the device (see DeMar Declaration, paragraphs 12, 13 and 14). Thus, Mol fails to teach or suggest all of the elements of the claimed invention. Because Mol fails to disclose a display device or indicator for gaming machines and is not pertinent to the problems of concern in the present invention, one of ordinary skill in the art of the present invention would not have considered Mol and therefore it would not have been obvious to one of ordinary skill in the art in view of Mol and Hoorn to arrive at the presently claimed invention (see DeMar Declaration, paragraph 10). Furthermore, like Hoorn, Mol fails to disclose or suggest a visual indicator of a gaming machine including multiple LEDs. Mol also fails to disclose or suggest a processor of a gaming machine providing for control of the color display of the external visual indicator. Thus, both Mol and Hoorn fail to disclose or suggest these elements required by claim 1 and combining these references does not alleviate their shortcomings.

The stationary external visual indicator mounted to a gaming machine of claim 1 is not obvious over Hoorn in view of Mol. One of ordinary skill in the art, in view of Mol and Hoorn would not have arrived at an invention of a gaming machine having a programmed processor providing for the control of the color display of the external visual indicator including multiple LEDs (see DeMar Declaration, paragraph 17). These limitations are also present in independent claims 18 and 40 (discussed below).

Mol is not concerned with the same field as Hoorn and there is no suggestion to combine the teachings of Mol with Hoorn (see DeMar Declaration, paragraphs 8, 11). The PTO has failed to indicate specifically where such a suggestion exists in Hoorn or Mol for combination or to

show that what was commonly known by those of ordinary skill in the art would have motivated such a combination. Although, the PTO has provided a Citation of Pertinent Prior Art in order to “show common engineering design considerations in the sign arts”, it is respectfully submitted that the PTO has still failed to provide a convincing line of reasoning why it would be obvious to combine Hoorn and Mol.

None of the patents provided in the PTO’s Citation of Pertinent Prior Art provides the motivation to combine Mol with Hoorn. Some of the patents included in the Citation of Pertinent Prior Art disclose that incandescent bulbs have been replaced with LEDs. However, the reasons for making these replacements are unrelated to the reasons for the use of LEDs in Applicant’s invention. The purpose for the use of LEDs in the present invention is to increase the message sending capabilities of the gaming machine and increase the numbers of colors that are available in order to increase such message sending capabilities. The present invention is also concerned with non-alphanumeric coded signaling via stationary multi-colored indicators of gaming machines (DeMar Declaration, paragraph 9).

The present invention does not have as its primary purpose the substitution of LEDs in order to increase the longevity of the light emitters nor for efficiency. The prior art of the Citation of Pertinent Prior Art only concerns replacing LEDs with incandescent bulbs in order to increase longevity or efficiency of the light device. For example, patent no. 4,682,147 teaches the use of LEDs in an exit sign so that during power outages the LED will take less power from a battery. Many of the cited prior art references are safety devices which are enhanced when the longevity of the light emitting device is increased. For example, patent no. 6,239,716 concerns taillights of an automobile, patent no. 5,575,459 relates to exit signs and patent no. 5,850,126 concerns traffic signals. Therefore, none of these Citations of Pertinent Prior Art relate to the

problem that is being solved in Applicant's present invention and fail to provide the motivation or suggestion for one of ordinary skill in the art that is missing in Mol, in order to combine its teaching with Hoorn.

Mol is not reasonably pertinent to the problems of concern in the present invention because Mol is concerned with alpha-numeric and graphical communication via movable display devices. Mol does not solve the problem of generating non-alphanumeric, coded signaling via stationary multi-colored indicators of gaming machines, that the present invention is concerned with (see DeMar Declaration, paragraphs 9 and 15). Thus, Mol fails to provide a suggestion for its combination with Hoorn and each of the patents of the Citation of Pertinent Prior Art also fail to provide such a suggestion or motivation.

Therefore, the rejection under Section 103(a) is improper. The PTO's lack of citation in Hoorn or Mol, as to where there is a suggestion to combine underscores the PTO's failure to establish a *prima facie* case of obviousness. In view of the lack of a suggestion to combine Mol with Hoorn, one of ordinary skill in the art would not have been motivated to combine Mol with Hoorn and therefore would not have arrived at an invention of a gaming machine having a visual indicator mounted to the gaming machine and including multiple LEDs and a programmed processor providing for the control of the color display of the external visual indicator. (See DeMar Declaration, paragraph 11).

As well, substitution of an LED of Mol in the candle of Hoorn will change the principle operation of Hoorn. If one of skill in the art attempted to combine the light displays of Mol into the candle of Hoorn, substantial modification is necessary. One of ordinary skill in the art could not just substitute the movable LED arrangements of Mol with the stationary light bulb of Hoorn without substantial modification (see DeMar Declaration, paragraph 16). Such substitution

without modification would change the principle operation of Hoorn. Thus, these references are not sufficient to render the claims *prima facie* obvious. If you attempt to modify the moveable light displays of Mol, there is no teaching provided for such modification and one of ordinary skill in the art could not make the modification. There is also no teaching in Mol of how the rotatable and moveable LEDs should be modified in order to operate in the stationary device of Hoorn that is mounted to a gaming machine, as claimed by claims 1, 18 and 40. There also is no teaching of how the LEDs of Mol would be arranged to be responsive to an input operation by a user of a gaming machine or a first special event of a gaming machine, as claimed by claims 1 and 18.

Therefore, there is no suggestion to combine Mol with Hoorn and one of ordinary skill in the art would not have been motivated to combine Mol with Hoorn and would not have arrived at an invention of a gaming machine having a programmed processor providing for the control of the color display of the external visual indicator including multiple LEDs (see DeMar Declaration, paragraph 17).

CLAIM 18

Claim 18 has been amended and includes a method comprising the steps of providing a gaming machine having a programmable external visual indicator including LEDs connected to a processor of the gaming machine, coordinating the external visual indicator with a first special event of the gaming machine, programming the processor so that a first customized illumination pattern is provided by the external visual indicator in order to designate the first special event and the processor automatically triggering the first customized illumination pattern of the external visual indicator upon the occurrence of the first special event. Hoorn and Mol, alone or in combination, fail to disclose or suggest all of the elements of claim 18. For example, both

Mol and Hoorn fail to disclose or suggest the processor automatically triggering the first customized illumination pattern of the external visual indicator upon the occurrence of the first special event. Hoorn fails to disclose a processor of the gaming machine for providing control of the color display of the external visual indicator. Although Mol discloses a human being triggering illumination of the device upon the occurrence of an event, such as a policeman pressing a button on the device of Fig. 1; Mol does not disclose or suggest a processor automatically triggering illumination upon occurrence of a first special event. Thus, Mol has no disclosure or suggestion of a processor automatically illuminating a pattern upon the occurrence of a first special event. Therefore, neither Hoorn nor Mol, alone or in combination, teaches or suggests a processor automatically triggering a first customized illumination pattern of an external visual indicator upon an occurrence of a first special event. (See DeMar Declaration, paragraph 18).

As well, for the reasons discussed above, Hoorn and Mol fail to disclose a programmable external visual indicator including LEDs connected to a processor of the gaming machine. Claims 19-39 and 57 and 58 depend from claim 18 and include all the limitations thereof. Therefore, none of these claims are obvious in view of Hoorn or Mol.

CLAIM 40

Amended claim 40 requires a user input panel provided by the gaming machine connected to the processor by which a first multi-colored illumination pattern may be selected and by which the user may indicate a first special event that will automatically trigger the first multi-colored illumination pattern to be displayed within a single stage of the candle. As discussed above, both Hoorn and Mol fail to disclose or suggest the automatic triggering of an illumination pattern upon a first special event. Further, neither Hoorn nor Mol disclose or

suggest a multi-colored illumination pattern to be displayed within a single stage of the candle. Hoorn discloses a single color within each stage of the candle. There is no teaching or suggestion of a multi-color illumination within a single stage of the candle of Hoorn. The use of incandescent bulbs of Hoorn and color shells on the outer sides of the candle would make such multi-color illumination within a single stage of the candle improbable.

Similarly, Mol fails to disclose multi-color illumination. While Mol indicates that different colored LEDs may be used in different devices, he does not disclose or suggest that such different colors may be used in a single device to provide for illumination of multiple colors at a single time within a single row or group of LEDs. Further, there is no disclosure or suggestion in Mol of using multi-colored LEDs within a single stage of a device. As well, Mol fails to disclose a candle or any other device for a gaming machine. Therefore, it would not have been obvious to one of ordinary skill in the art in view of Mol or Hoorn to arrive at the invention of claim 40. Neither Hoorn nor Mol, alone or in combination, teaches or suggest a first multi-colored illumination pattern that may be selected and by which a user may indicate a first special event that will automatically trigger the first multi-colored illumination pattern to be displayed within a single stage of the candle. (DeMar Declaration, paragraph 19).

Furthermore, claim 40 requires that there is a current driver connected to multiple LEDs mounted in the candle. Hoorn fails to teach or suggest LEDs, as discussed above, and it would have been improper to combine Mol with Hoorn. Therefore the use of LEDs as provided in claim 40 would not have been obvious to one of ordinary skill in the art in view of Hoorn and Mol. Claims 41-46 depend from claim 40 and include all the limitations thereof. Therefore, none of these claims are obvious in view of Hoorn or Mol.

CLAIM 47

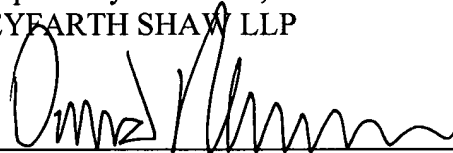
Claim 47 requires a programmed processor providing for the control of an external visual indicator via an input operation to trigger an operation sequence including illumination of a first color display upon occurrence of a first special event and automatically triggering a second color display upon occurrence of a second special event. Neither Hoorn nor Mol either alone, or in combination, teach or suggest all of the elements of claim 47. Both Hoorn and Mol fail to disclose or suggest an operation sequence that may be programmed in response to an input operation by a user as required by claim 47. In particular, Hoorn and Mol fail to disclose the operation sequence automatically triggering the second color display upon occurrence of the second special event. Mol discloses only a single mode of operation in which the LEDs are either turned "on" or "off." There is no teaching or suggestion that a change to a second mode of operation is triggerable by a second event. Further, there is no teaching or suggestion in Hoorn or Mol of a programmed processor providing for the automatic triggering of the second color display upon occurrence of the second special event. While Hoorn may suggest different events, it is not programmable by the user for first and second color displays upon occurrence of the first and second special events. Neither Hoorn nor Mol, alone or in combination, teaches or suggests a programmed processor providing for the control of an external visual indicator via an input operation to trigger an operation sequence including illumination of a first color display upon occurrence of a first special event and automatically triggering a second color display upon occurrence of a second special event. (See DeMar Declaration, paragraph 20). Claims 48-56 depend from 47 and include all the limitations thereof and are also allowable.

Appl. No. 10/008,748
Amt. dated January 16, 2004
Reply to Office action of Aug. 18, 2003

Therefore, claims 1-56 are allowable as the limitations of the claims and are not taught or suggested by Hoorn in view of Mol. Therefore, the rejection under §103(a) of claims 1-46 is improper and applicant respectfully requests that it be withdrawn and all claims be allowed.

If the examiner has further questions or would like to discuss the application, please contact counsel for Applicant as provided below.

Respectfully submitted,
SEYFARTH SHAW LLP

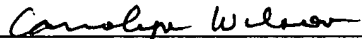


David L. Newman
Registration No. 37,196
Attorney for Applicant

SEYFARTH SHAW LLP
55 East Monroe Street
Suite 4200
Chicago, Illinois 60603
(312) 346-8000

CERTIFICATE OF MAILING

I hereby certify that, on 1/16/04 this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



Carolyn Wilson